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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/665,743

09/20/2000

Eric Rosen

990341

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23696

7590

06/03/2004

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

HARPER, KEVIN C

ART UNIT

PAPER NUMBER

2666

11

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/665,743

Applicant(s)

ROSEN ET AL.

Examiner

Kevin C. Harper

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12, 14-17, 19-22, 27-30 and 32-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-12, 14-17, 19-22, 27-30 and 32-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Arguments

Applicant's arguments filed March 22, 2004, have been fully considered but they are not persuasive.

1. Applicant argued that McTuffin does not disclose transmitting a data origination message and information needed to construct a data network header at the receiving station. However, McTuffin discloses transmitting an inherent data origination message used to establish a connection (col. 3, lines 20-21) and information needed to reconstruct a data network header (Figure 2, item 10; col. 2, lines 20-27).

2. Applicant argued that McTuffin does not disclose transmitting an acknowledgement or performing the steps in the order recited. However, an inherent data origination message and acknowledgement are transmitted to establish a connection (col. 3, lines 20-21). A CDMA code is mapped to ATM header values when establishing a connection and ATM packets subsequently transmitted for the connection lack data network header information such as VCI, VPI, HEC and GFC (col. 3, lines 16-20, 26-28 and 38-41; col. 2, lines 28-35).

3. Applicant argues that McTuffin does not disclose receiving formatted information from a communications device to be transmitted to a destination device. However, the formatted information received at Figure 2, item 2 lacks data network header information. The information field does not include data network header information (col. 2, lines 66-67; col. 1, lines 14-16; col. 2, lines 28-33).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2666

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-7, 9-12, 15-17, 19-22, 24-30 and 32-35 are rejected under 35 U.S.C. 102(b) as being anticipated by McTuffin (US 5,046,550).

4. Regarding claims 2, 5, 7, 9-10, 19-20, 22, 26, 29, 32 and 35, McTuffin discloses an apparatus for reducing transmission overhead in a communications system (Figure 1, item 17) comprising an inherent processor for generating an inherent data origination message (col. 3, lines 20-21), initiating a communication with a receiving station (Figure 1, item 19; col. 3, lines 20-21), transmitting subsequent to the data origination message information needed to construct data network header information at the receiving station (col. 3, lines 35-44) and formatting information to be transmitted without a data network header information (col. 3, lines 35-37). Further regarding claim 24 information is not transmitted until an inherent acknowledgement is received because a connection is established between a mobile station and a base station (col. 3, lines 20-21). Further regarding claims 9, 25 and 29, the receiver has an inherent storage device (Figure 2, INFORMATION FIELD & RESIDUAL HEADER, CDMA CODE USED).

5. Regarding claims 3-4, 11-12, 21, 27-28 and 33-34, the data network header information are the VCI and VPI header addresses.

6. Further regarding claims 6, 30 and 36-38, information is not transmitted until an inherent acknowledgement is received because a connection is established between a mobile station and a base station (col. 3, lines 20-21).

7. Regarding claims 14-17, data packets without network headers are transmitted to a second device (col. 4, lines 35-38; col. 3, lines 20-21; Figure 2, item 8).

Art Unit: 2666

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over McTuffin (US 5,046,550) as applied to claim 5 above.

8. McTuffin does not disclose transmitting at least one data packet with a network header (col. 1, lines 35-48 and 51-54; note: the invention of McTuffin provides advantages and efficiencies over prior methods of transmitting data packets with network headers). It has been held that omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969) (omission of a reference element whose function is not needed would be obvious to one skilled in the art). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to transmit a data packet with a network header in the invention of McTuffin when achieving an efficient transmission is not necessary or desired.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2666

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Harper whose telephone number is 703-305-0139. The examiner can normally be reached weekdays, except Wednesday, from 9:30 AM to 8:00 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao, can be reached at 703-308-5463. The centralized fax number for the Patent Office is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office for TC 2600 at 703-306-0377.

Kevin C. Harper



May 26, 2004

Seema S. Rao
SEEMA S. RAO 5/27/04
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600